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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,333	08/04/2003	Guenter Berschel	FA1194USNA	6771

23906 7590 12/20/2005

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WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,333

Applicant(s)

BERSCHEL ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9 and 11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-6,9 and 11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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Response to Amendment

1. Amendment filed on 10/26/2005 has been entered. Claims 2, 7, 8, 10 have been cancelled. Claims 1, 3-6, 9, 11 are pending in the application.

Election/Restrictions

2. Applicant's election of Group I, claims 1, 3-6, 9, 11 in the reply filed on 10/26/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3, 9, 11 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson et al (US 6,592,999) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 7/26/2005.

6. Claims 4, 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al (US 5,075,370) and Briselli et al (US 5,466,286) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 7/26/2005.

7. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al and Briselli et al, further in view of Schlaak (US 5,976,343) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 7/26/2005.

Response to Arguments

8. Applicants' arguments filed 10/26/2005 have been fully considered but they are not persuasive.

(A) Applicants argue that the rejection based on anticipation by Anderson must be withdrawn. Applicants method is directed to the refinishing of multi-coated substrates.

Applicants' claims are directed to a refinishing method. Further, **Applicants process requires the application of two base coats whereas Anderson applies a primer and a base coat.**

Applicants apply a clear lacquer topcoat whereas Anderson applies a powder topcoat layer. **A powder is not a lacquer.** In regard to the obviousness rejection of the claims, the Examiner stated that Anderson shows a method for forming multilayer coatings that have improved interlayer adhesion where the substrate is precoated with an electrocoat primer and a primer/surfacer and a gray solvent born primer (first coat) are applied by spray application and a water born silver basecoat (claimed metallic effect pigment basecoat) is applied and a powder

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clear coating is then applied. The interlayer adhesion of the coatings is improved by the inclusion of adhesion promoters. The Examiner stated that such a multi-layer coating could be used for automotive refinishing.

The Examiner respectfully disagrees with this argument. First of all, in contrast to Applicants' interpretation of the Examiner's statement, the Examiner stated that Anderson shows a method comprising applying to a substrate precoated with an electrocoat primer, a primer/surfacer and a **BASECOAT** by spray application with gray (claimed solid color) solventborne primer (claimed first coat of paint) and a waterborne silver (claimed metallic effect pigment) **basecoat**, applying powder clear coating compositions to the basecoat (See column 62, lines 22-48). In other words, Anderson teaches **expressly** that the process requires the application of **two basecoats**. **Therefore, Applicants' statement that Applicants process requires the application of two base coats whereas Anderson applies a primer and a base coat is incorrect.**

As to the Applicants' statement "A powder is not a lacquer", it is well known in the art that lacquers may be made either in solvent-based or in *powder* form, as evidenced by Hovestadt et al (US 5,344,851, column 3, lines 37-39) and Schuller (US 6,286,687, column 1, lines 14-18). Moreover, a word "lacquer" is defined in the Merriam-Webster's Collegiate Dictionary, tenth edition as "*any of various clear or colored synthetic organic coatings*". **Therefore, powder clear coating composition of Anderson et al reads on claimed clear lacquer.**

As to refinishing method, it is well known in the art that the refinishing is *repeat finishing*, as evidenced by Rink et al (US 20040214912, P8). Rink et al show that the refinishing or *repeat finishing* of a high-quality multicoat color and/or effect paint systems imposes exacting demands on the refinish materials and the refinish process. It is particularly the

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case with the line refinishing of coated autobodies where the original (OEM) finish requires extensive or complete recoating (repeat finishing). The colors and/or optical effects in the refinish must not differ from those of the original finish. Moreover, the refinish must adhere firmly to the original finish. See P8. Therefore, clearly, all three-layer coatings of Anderson can be used for **repeat finishing** (*refinishing*) because of the improved *interlayer adhesion* between any of the layers, or it would have been obvious to one of ordinary skill in the art to have refinished the car painting using all three layer coatings depending on defects.

(B) Applicants argue that Anderson's invention is directed to solving the problem of intercoat adhesion of various layers of a multi-layer coating and accomplishes that by incorporating boron containing compounds. Applicants' do not use boron containing compounds in any of the coating layers of their process. The paint utilized in each of the solvent borne first basecoat layer, the second water borne basecoat layer and the clear coat layer clearly set forth as "consisting of" which does not allow for the presence of boron containing adhesion promoters which are required by Anderson but not by Applicants.

The Examiner respectfully disagrees with this argument. Applicants' claims recite that paints "consist of" solvent borne composition, water borne composition and clear coat. But *nowhere* claims recite that compositions or clear coat "consist of" components which exclude boron containing compounds.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
ETsoy

December 14, 2005